

the following inventions:

- I. Claims 1-9 (sic) and 17-25 drawn to apparatus, classified in class 606, subclass 139.
- II. Claims 11-16 and 18-31 drawn to method of using, classified in class 606, subclass 139.

I. Restriction

The Examiner contends that the two inventions are independent and distinct, each from the other, as they have acquired a separate status in the art as shown by their separate subject matter for inventive effort. However, the classifications and subclasses shown above are identical. Further, the Examiner contends that in the instant case the product as claimed can be used in different process. It is contended that the apparatus claims relate to a tubular member with a plunger slidably received within the tubular member. However, these elements are listed without the teachings of the specification or the limitations of the preamble. The Examiner contends, without any support, that the device as claimed may be used as a suction device, or may be used to support another portion of the body. Thus, it is wrongly concluded that this device may be used in a number of processes, not limited to that of the method claims. Not only is this the wrong criteria for restriction, but basically inaccurate.

Restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 1-9 and 17-25, drawn to apparatus, classified in class 606, subclass 139.
- II. Claims 11-16 and 26-31, drawn to method of using, classified in class 606, subclass 139.

II. Arguments

Applicant thanks the Examiner for the interview regarding this restriction. During the interview the Examiner amended the restriction of the apparatus to include claim 10 which was inadvertently omitted from the original restriction. A copy of the interview summary is attached to this response as required by the rules.

The Examiner is respectfully reminded that the MPEP is not law, but merely an interpretation by the Office of the Statutes, Rules and Regulations. Restriction is only applicable to independent and distinct inventions, which are patentably distinct one from the other (37 CFR§ 1.141(a)) and, importantly, the process of using a product are permissibly joined with claims directed to the product (37 CFR §1.141(b)).

Restriction is only appropriate if two or more independent and distinct inventions are claimed in a single application (37 CFR §1.142(a)). Even in accordance with MPEP 808.02, the Examiner must demonstrate patentable distinctness of the two restricted inventions. This is done by a showing that the two inventions have (a) separate PTO classification, (b) separate status in the art, or (c) separate fields for searching the relevant prior art. The Examiner has failed to meet even these basic criteria indicating that both sets of claims are classified in the same classes and subclasses. Moreover the MPEP (802.01) defines “**independent**” inventions as inventions with "no disclosed relationship," or in other words "they must be unconnected in design, operation, or effect". Therefore, on its face, and in accordance with MPEP, as well as 37 CFR, this restriction is inappropriate and should be removed.

During the interview, the Examiner mentioned art, which she believed relevant to the apparatus claims. The cited patent US 6,383,208 is directed to closing the walls of a breach or lesion (suturing) in a physiological shell structure, i.e. skin. This art has absolutely nothing to do with the invention (method or apparatus) claimed in the instant application. It is respectfully submitted that 35 USC §112 makes the claims, as originally filed, part of the specification. It is inappropriate, therefore, to read elements of a claim *In Vacuo*, that is the claimed elements cannot be read without reference to the specification (see *Phillips v. AWH Corp.*, 376 F.3d 1303 (Fed. Cir. 2005)).

If in fact, the Examiner is objecting to the claims as being broad and indefinite, a restriction requirement is inappropriate and must be removed. The appropriate response is a rejection under 35 USC §112¶2. Moreover, the Examiner contends that all of the apparatus claims are patentably distinct, yet indicated during the interview that the application contained “allowable apparatus claims”, which were able of use in accordance with the method as claimed. Thus, the two cannot be patentably distinct by definition.

There is a further reason for removing this requirement in that it will require filing of divisional applications thus creating a number of file histories directed to related claims. This unduly prejudices Applicant and may, in fact, result in loss of allowable patent rights.

III. Election

Applicant, without waving rights to the other invention(s) claimed in this application, hereby provisionally elects without prejudice claims Claims 11-16 and 18-31 drawn to method of using.

IV. Conclusion

Applicant respectfully traverses the Examiner's restriction requirement for the above reasons. Removal of the restriction requirement is hereby respectfully requested.

The Examiner is respectfully requested to commence examination of the instant elected claims, in order for Applicant to determine their need to file further applications as soon as possible. The Examiner's cooperation in this matter is appreciated. If the Examiner has any questions, Applicant requests that the Examiner telephone the undersigned.

Applicant believes that no fees are due with respect to this paper.

Respectfully submitted,

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SIGNATURE OF PRACTITIONER

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